

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

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|----------------------|---|--------------------------|
| In re Examination of |) | DECISION ON PETITION |
| |) | FOR REVIEW OF DIRECTOR'S |
| |) | FINAL DECISION UNDER |
| |) | 37 CFR § 10.2(c) |
| |) | |

I

Petitioner asks the Commissioner to review a decision of the Director of the Office of Enrollment & Discipline (OED) dated February 24, 1992, denying relief on request for regrade of the afternoon section of the registration examination held on August 21, 1991. The Director's decision has been reviewed. The relief requested is, in the entirety, denied.

II

In Part I, Option A, of the afternoon section of the exam, petitioner was instructed:

[P]resent a new single independent claim which defines the novelty of the invention as set forth in the object of the invention and which distinguishes your client's invention over the teachings of the Dude patent and the admitted prior art.

Your claims must include and interrelate at least the following elements: the head, the handle, the light source, the power source, the metal strip, the reflector, and the switch.

You may not be your own lexicographer to name the elements of the disclosed invention. You must use the terminology set forth in Dude's disclosure. . . . Points will be deducted for claiming subject matter which is not within the scope of the invention shown in the Figure of or described in Dude's application, for

using language which is indefinite or which does not have antecedent basis, [and] for failing to interrelate the elements or components in your claim

The general DIRECTIONS for the exam instructed:

The most correct answer is the policy, practice and procedure which must, shall or should be followed in accordance with the patent statutes, PTO rules, and the Manual of Patent Examining Procedure (MPEP).

III

The claim petitioner drafted reads as follows:

4. A brush device comprising:
 - a handle;
 - a head connected to said handle;
 - a light source disposed in said handle;
 - a metal strip disposed in said handle;
 - a power source electrically connected to said light source by said metal strip;
 - a plurality of fiber optic strands in said handle and protruding through said handle into and through said head;
 - a reflector interspersed between said light source and said plurality of fiber optic strands in a manner transmitting and magnifying said light source; and
 - a switch interconnected with said power source, said handle, and said light source to permit control of said power source.

IV

The grader deducted points as indicated below:

- 2 points: handle "not interrelated" to the head
- 4 points: light source and metal strip "not interrelated with each other or to switch and reflector"
- 2 points: power source electrically connected to light source "by reflector, not strip"

- 2 points: "reflector not interrelated to light source and metal strip"
- 6 points: "claim does not provide for optic fibers forming bristles"
- 8 points: "no magnification means provided"
- 4 points: "Novelty not clearly defined. Optical fibers transmit light and also function as bristles such that light is emitted from tips of bristles in close proximity to surface to be brushed."

V

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

35 U.S.C. § 112, second paragraph. Claims need only reasonably apprise those skilled in the art as to their scope and be as precise as the subject matter permits. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986). The Director agreed with the grader's holding that the claim petitioner drafted did not comply with the second paragraph of § 112. The Director's comments are paraphrased in In re Goehring, 77 F.2d 655, 657, 25 USPQ 463, 465 (CCPA 1935):

[The] claims . . . are indefinite. These claims specify that certain control means are so inter-related that a condition of

each control will be in predetermined relation to certain other controls. It is the office of a claim to point out the relation of the parts by which a desired result is effected. Obviously the language used in these claims leaves the relationship wholly indeterminate.

The Director agreed that "the language 'connected to' is a structural limitation which may be interpreted to mean a direct or indirect connection of elements." In re Folkenroth, 275 F.2d 732, 734, 125 USPQ 185, 187 (CCPA 1960). The problem with the use of the phrase in the claim petitioner drafted is that "in accordance with the instructions [and law], the interrelationship of the elements had to be more particularly defined." How are the head and the handle directly or indirectly connected? How are the light and the metal strip disposed in the handle? How is the power source directly or indirectly connected to the light source by the metal strip? How and where are the fiber optic strands disposed in the handle? How and where do the fiber optic strands protrude through the handle into and through the directly or indirectly connected head? How is the reflector interspersed between the light source and the fiber optic strands so to transmit and magnify the light source? How are a switch, the power source, and the light source directly or indirectly interconnected to permit control of the power source. The light, handle, head,

battery, reflector, metal strip, and fiber optic strands may be directly or indirectly connected, disposed, interspersed, and interconnected consistent with the principle of patent law that claims are to be given their broadest reasonable interpretation consistent with the specification. The problems with the terms petitioner employed in his attempt to interrelate elements of the applicant's invention are:

(1) the multiple connections and interconnections of elements are not defined in a manner which reasonably apprises the skilled artisan of the scope of the claim;

(2) the elements of the illuminated brush may connect, interconnect, be disposed, be dispersed, and protrude through and into other elements in an inoperative manner; and

(3) the elements of the illuminated brush may connect, interconnect, be disposed, be dispersed, and protrude through and into other elements in ways inconsistent with and broader in scope than the subject matter applicant regards as his invention.

Petitioner was specifically directed to use definite language and language which has antecedent basis in the specification. The Director agreed with the grader that petitioner did not follow the directions in multiple parts and the whole of the claim he drafted.

Furthermore, petitioner was instructed to present a claim which defines the novelty of the invention as set forth in the object of the invention. Petitioner urges that the claim need

not recite that the fiber optic stands form the bristle protruding from the head or specify a magnification lens to define an invention which is novel over the prior art. Whether or not petitioner is correct in an assessment of novelty outside the scope of the instructions is irrelevant. Points were deducted because petitioner did not draw a claim "particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention" as required under 35 U.S.C. § 112, second paragraph. Petitioner's view of the novel aspects of the invention disclosed is irrelevant. In the specification applicant instructs:

[I]t is the object of the present invention to provide a brush device having plastic fiber optic filaments which act as bristles and which transmit light having greater intensity than the original light source to the tips of the bristles The magnification means is essential to the operation of the brush device because of the necessity to concentrate and intensify the light into the optic fiber filaments to intensify the light emitted from the tips of the bristles.

It is applicant's intent to "illuminate the area in close proximity to the bristles." The claim petitioner drafted is not considerate of applicant's objectives; i.e., petitioner

disregarded the "subject matter which applicant regards as his invention." Given its broadest reasonable interpretation, the claim petitioner drafted may not and, it is submitted, cannot fulfill the objectives applicant had for his invention for the full scope of the subject matter claimed. The grader deducted an appropriate number of points.

VI

A claimed invention is novel if no single prior art reference discloses every one of its elements. The Director did not indicate otherwise. The Director said:

The novel feature of the invention is not only the use of fiber optic strands to transmit light but also that these same fibers form the brush bristles.

Yes, the claimed invention may be novel because of a single novel feature. However, the use of fiber optic strands to transmit light itself is not a novel feature. Therefore, the novelty of the invention described by applicant does not stem from that feature alone. The novelty lies in the particular manner in which old elements combined are interrelated.

VII

The general DIRECTIONS to the afternoon section of the exam instruct:

The most correct answer is the policy, practice and procedure which must, shall or should be followed in accordance with the patent statutes, PTO rules, and the Manual of Patent Examining Procedure (MPEP).

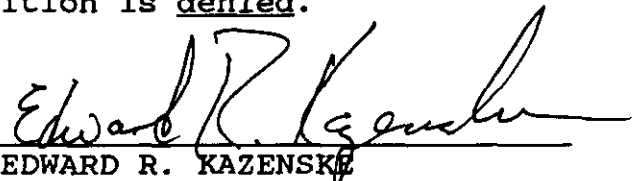
Petitioner argues that answer c) to Question 3 of Part III of the afternoon section is correct because there is no antecedent support for the phrase "sequentially applied alloys" in Claim 1. The phrase may not expressly appear in Claim 1, but there is "antecedent support" for the phrase in the composite formed by the process including the step of "sequentially applying a plurality of different molten solder alloys" in Claim 1. Even if answer c) could be correct under certain possible interpretations of the claim language, answer c) is not correct under every and the most reasonable interpretation of the claim language. On the other hand, in accordance with the DIRECTIONS, answer d) is most correct. Regardless of how one interprets the language of the claims, Claim 2 further limits Claim 1.

VIII

The relief requested on petition is denied.

Date:

15 April 1992


EDWARD R. KAZENSKE
Director of
Interdisciplinary Programs

cc: